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In re Application of :
SIMMONS et al :
U.S. Application No.: 10/565,415 :
PCT No.: PCT/US04/24013 :
Int. Filing Date: 26 July 2004 : DECISION
Priority Date: 25 July 2003 :
Attorney Docket No.: UTSG263US :
For: COMPOSITIONS AND METHODS FOR :
HERPES SIMPLEX PROPHYLAXIS :
AND TREATMENT :

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 14 September 2006.

BACKGROUND

On 14 February 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 14 September 2006, applicants filed a response which was accompanied by, *inter alia*, the subject petition, a declaration signed by one of the two named inventors; a declaration by Collin Evans; a five-month extension and fee; the petition fee of \$200.00; and the \$130.00 surcharge fee.

DISCUSSION

Applicants claim that they have been unable to locate a joint inventor, Jianmin Chen and have filed the subject petition in response to the Form PCT/DO/EO/905 mailed 14 February 2006.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the

10/565,415

nonsigning joint inventors.

Concerning item (1), the petition fee of \$200.00 has been paid.

With regards to item (3), the last known address of co-inventor Jianmin Chen is listed as:

U.T Medical Branch at Galveston
Virology - Department of Pediatrics
301 University Blvd. MS 372
Galveston, TX 77555

Thus, both items are complete.

Regarding item (2), applicants' burden in showing that an inventor cannot be located is explained in section 409.03(d) of the MPEP which states, in part:

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions . . .

The 37 CFR 1.47(a) applicant has not met the requirements of proving that a diligent effort was made to contact the nonsigning co-inventor. While an internet search on Google was performed (and documentary evidence provided), no further attempt was identified.

Petitioners should attempt to determine if Mr. Chen's former employer at the University of Texas Medical Branch (or former co-workers) have further information concerning his whereabouts. It is highly unlikely that Mr. Chen left no information with his employer. Moreover, a telephone search should also be made. These efforts are not extraordinary and should be made to demonstrate that a diligent effort was made to locate the nonsigning joint inventor.

For the reasons noted above, item (2) of 37 CFR 1.47(a) is not yet satisfied.

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by one of the two co-inventors on behalf of themselves and the nonsigning joint inventor. However, it appears that the second page of the declaration is missing and the citizenship of the inventors are not recorded on the declaration. As such, this declaration fails to comply with 37 CFR 1.497(a) and (b). Applicants need to submit a complete declaration signed by the inventor in the signature block of page two of the declaration. A notary is not required. For these reasons, item (4) is also not satisfied.

All requirements of 37 CFR 1.47(a) are not yet satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are authorized under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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